

REMARKS**Claim Rejections – 35 USC §102**

Claim 7-10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4394891 to Oshima.

For a rejection grounded in anticipation under 35 U.S.C. § 102 to be proper, every element and limitation recited in the rejected claim(s) must be found in the cited 35 U.S.C. § 102 reference. See MPEP § 2131. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Id.*, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). See also, *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1994). The MPEP restricts the prior art that may be cited by an Examiner in making a 35 U.S.C. § 102(b) rejection to those where the “identical invention [is] shown in as complete detail as is contained in the ... [rejected] claim.” *Id.*, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The Examiner states that, Oshima discloses, inter alia, “a spring assembly 9 to adjust a clearance between the brake lining and the brake disc after brake application.” Applicants respectfully disagree.

Applicants’ spring assembly 10, 20 acts on the brake lining in the axial direction so that the brake lining is removed from the brake disc after brake application. See paragraph [0016] which states, “the brake lining is displaced in opposition to *the axial biasing force of the spring clip 12 tending to urge the brake lining in the direction of the actuating device 5.*” As such, Applicants’ claim 1 recites, “a spring assembly (10, 20) to adjust a clearance between the brake lining (4) and the brake disc after brake application,” (emphasis added). Claim 13 similarly recites, “adjusting a clearance between the brake lining (4) and a brake disc after brake application.”

Oshima discloses a spring assembly 9 which acts to bias the friction pads in a radially inward direction (see claim 1). The radial bias is to “prevent vibration of the caliper and of the friction pads and to suppress chattering noise in operating the vehicle” (column 1, lines 28-31). The bias applied by the spring assembly 9 to the friction pads is in the radial direction not the axial direction. The radial bias provided by spring assembly 9 does not affect the axial positions of the brake lining and the brake disc. Further, the bias is to prevent brake noise, not to adjust a clearance between the brake lining and the brake disc. Therefore, Oshima does not teach a spring to “adjust a clearance between the brake lining (4) and the brake disc,” as recited in

Applicants' claim 1. Thus, Oshima does not teach each and every element recited in Applicants' claim 1 and claim 1 is allowable over Oshima. Claim 13 includes a similar limitation and is allowable for at least these same reasons. Claims 2-12 and 14 are dependent from claims 1 and 13 and are allowable for at least these same reasons. Therefore, withdrawal of the §102 rejection of the claims is respectfully requested.

Claim Rejections – 35 USC §103

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima in view of US Patent 2711801 to Super et al.

Obviousness is a question of law based on factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). See MPEP §2141. The Graham factual inquiries include (A) determining the scope and content of the prior art; (B) ascertaining the differences between the claimed invention and the prior art; and (C) resolving the level of ordinary skill in the art. *Id.* "The question of obviousness must be resolved on the basis of these factual determinations. While each case is different and must be decided on its own facts, the *Graham* factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis." *Id.*

A proper rejection under 35 U.S.C. §103(a) requires that, the Examiner must establish an "apparent reason" to modify the reference or to combine reference teachings. *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). According to the United States Supreme Court, "[o]ften, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit." *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), slip op. at 14.

Oshima does not disclose, "a spring assembly (10, 20) to adjust a clearance between the brake lining (4) and the brake disc after brake application," as required by Applicants' claim 1, from which claim 11 depends. Super et al. fails to remedy this initial deficiency of Oshima and the Examiner has not provided a reason to modify the combined references to do so. Additionally, Super et al. teaches a drum brake and Oshima teach a disc brake. Therefore, components used on the drum brake of Super et al. will not provide the same results on the disc brake of Oshima. Thus, claim 11 is allowable over Oshima in view of Super et al. for at

least these reasons. Withdrawal of the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested.

CONCLUSION

Accordingly, Applicant believes that the claims overcome the raised objections and rejections and are in a condition for allowance.

Applicants do not believe any fees are due in connection with the filing of this Response. If, however, Applicants are in error and there are additional fees due, including any extension fees, please charge all such required fees to Deposit Account 50-2570.

Respectfully submitted,

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